REMARKS

Claims 1-9, 11-20, 22-26 and 28-30 are pending in the application.

The Applicants respectfully request the Examiner to reconsider earlier rejections in light of the following remarks. No new issues are raised nor is further search required as a result of the changes made herein. Entry of the Amendment is respectfully requested.

Claims 1, 12 and 22 over Miner in view of Bartholomew

In the Office Action, claims 1, 12 and 22 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Miner et al., U.S. Patent No. 6,021,181 ("Miner") in view of Bartholomew et al., U.S. Patent No. 5,631,948 ("Bartholomew"). The Applicants respectfully traverse the rejection.

Claim 1 recites, *inter alia,* a voice message that is initially stored in a voice message memory, and upon deletion of the voice message from the voice message memory, the voice message is **compressed**, moved and restored in a deleted voice message memory. Claims 12 and 22 recite, *inter alia*, removing a deleted voice message, upon deletion from a first memory area, **compressing** the deleted voice message, and storing the deleted voice message memory in a second memory area.

The Office Action correctly acknowledged that Miner fails to disclose **compressing** a voice message and storing the **compressed** voice message in a trash bin (Office Action, page 2). The Office Action relies on Bartholomew to allegedly make up for the deficiencies in Miner to arrive at the claimed invention. The Applicants respectfully disagree.

Bartholomew appears to disclose a system and method of effecting transfer of current messages only, such as a voice message, from one centralized messaging system to another centralized messaging system in a switched communications network (Abstract). Current voice messages only are compressed and stored on a hard disk that maintains the voice mail operating system and a processor controls file activities (Bartholomew, col. 1, lines 19-33).

The Office Action relies on Bartholomew to disclose compressing a voice message and storing the compressed voice message in a trash bin.

However, Bartholomew fails to even mention the use of a trash bin, much less compressing a voice message before storage in a trash bin. Bartholomew refers to file deletion only once, in the background of the invention, with no further actions taken once a voice message is deleted, i.e., the message is not placed in a trash bin. Bartholomew fails to make up for the deficiencies in Miner by failing to disclose or suggest moving a deleted voice message to a deleted voice message memory and a second memory area, much less a voice message that is **compressed**, moved and restored in a deleted voice message memory and a second memory area, as recited by claims 1, 12 and 22.

Moreover, even if Bartholomew were interpreted to have disclosed compressing a voice message and storing the compressed voice message in a deleted voice message memory and a second memory area, there is no suggestion why such a feature would be incorporated in Miner. Miner discloses a personal computer (see Miner, col. 3, lines 25-30) that uses a large volume storage device for storage of a relatively small number of current intercom messages. Miner does **NOT** require compression. Bartholomew's motivation to use compression is for transfer of a very large number of current messages stored in a centralized messaging system. This minimizes transfer bandwidth. Transfer concerns have nothing to do with a deleted message memory as claimed. Moreover, Bartholomew would teach away from compressing and transfer of any deleted messages as they would require yet more transfer bandwidth, which is to be avoided.

Neither Miner nor Bartholomew provide any motivation as to why any compression would be incorporated in Miner, much less for messages compressed, moved and restored in a deleted voice message memory and a second memory area. "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

Once a message has been listened to and deleted, the quality of a voice message becomes less important than during an initial review. By

compressing voice messages for storage in the deleted message memory area upon deletion, more deleted messages can be stored for potential later review. Such a benefit is not disclosed or suggest by the cited prior art.

Accordingly, for at least all the above reasons, claims 1, 12 and 22 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 1-5, 12-15 and 22-24 over O'Neal in view of Bartholomew

In the Office Action, claims 1-5, 12-15 and 22-24 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over O'Neal, U.S. Patent No. 6,411,685 ("O'Neal") in view of Bartholomew. The Applicants respectfully traverse the rejection.

Claims 1-5 recite, *inter alia*, a voice message that is initially stored in a voice message memory, and upon deletion of the voice message from the voice message memory, the voice message is compressed, moved and restored in a deleted voice message memory. Claims 12-15 and 22-24 recite, *inter alia*, removing a deleted voice message, upon deletion from a first memory area, compressing the deleted voice message, and storing the deleted voice message memory in a second memory area.

The Office Action correctly acknowledges that O'Neal fails to disclose or suggest compressing a voice message and storing the compressed voice message in a trash bin (Office Action, page 3). The Office Action relies on Bartholomew to allegedly make up for the deficiencies in Miner to arrive at the claimed invention. The Applicants respectfully disagree.

The Office Action relies on Bartholomew to disclose compressing a voice message and storing the compressed voice message in a trash bin. However, Bartholomew fails to even mention the use of a trash bin, much less storing a compressed voice message in a trash bin, with only one reference to file deletion in the background of the invention and no mention or suggestion of using a deleted voice message memory. Bartholomew fails to make up for the deficiencies in O'Neal by failing to disclose or suggest a voice message that is

compressed, moved and restored in a deleted voice message memory and a second memory area, as recited by claims 1-5, 12-15 and 22-24.

Moreover, even if Bartholomew were interpreted to have disclosed compressing a voice message and storing the compressed voice message in a deleted voice message memory and a second memory area, there is no suggestion why such a feature would be incorporated in O'Neal. O'Neal discloses storage of current messages, i.e., e-mail, voicemail, and facsimile messaging (see col. 1, lines 53-55), on a server's hard drive that has room to store such messages, **NOT** requiring compression. Bartholomew's motivation to use compression is for storage and transfer of a very large number of messages stored in a centralized messaging system, taxing system bandwidth.

Neither O'Neal nor Bartholomew provide any motivation as to why any compression would be incorporated in O'Neal, much less for messages compressed, moved and restored in a deleted voice message memory and a second memory area. "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

As discussed above, once a message has been listened to and deleted, the quality of a voice message becomes less important than during an initial review. By compressing voice messages for storage in the deleted message memory upon deletion, the number of deleted messages that can be stored is increased. Such a benefit is not disclosed or suggest by the cited prior art.

Accordingly, for at least all the above reasons, claims 1-5, 12-15 and 22-24 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 6 and 16-18 over O'Neal in view of Bartholomew and Pickett

In the Office Action, claims 6 and 16-18 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over O'Neal in view of Bartholomew, and further in view of Pickett et al., U.S. Patent No. 6,266,340 ("Pickett"). The Applicants respectfully traverse the rejection.

Claims 6 and 16-18 are dependent on claims 1 and 12 respectively, and are allowable for at least the same reasons as claims 1 and 12.

Claim 6 recites, *inter alia,* a voice message that is initially stored in a voice message memory, and upon deletion of the voice message from the voice message memory, the voice message is compressed, moved and restored in a deleted voice message memory. Claims 16-18 recite, *inter alia*, removing a deleted voice message, upon deletion from a first memory area, compressing the deleted voice message, and storing the deleted voice message memory in a second memory area.

As discussed above, O'Neal in view of Bartholomew fails to disclose or suggest that upon deletion of a voice message, the voice message is compressed, moved and restored in a deleted voice message memory and a second memory area, as recited by claims 6 and 16-18.

The Office Action relies on Pickett to allegedly make up for the deficiencies in O'Neal and Bartholomew to arrive at the claimed invention. The Applicants respectfully disagree.

Pickett appears to disclose a system in which voice/data communications may occur in multiple modes/protocols (Abstract). Various pieces of information, i.e., the status and operation of a communications system, are retained for a predetermined period of time and then purged (Pickett, col. 53, lines 37-43; lines 50-63). A DSP performs data compression and voice compression within the system (Pickett, col. 8, lines 48-64).

Although Pickett performs data compression and voice compression in a communications system, the data compression and voice compression is performed on current messages, **NOT** performed upon deletion of a voice message from a memory, as recited by claims 6 and 16-18.

Neither O'Neal, Bartholomew nor Pickett, either alone or in combination, disclose, teach or suggest compression that is performed upon deletion of a voice message from a memory, as recited by claims 6 and 16-18.

Accordingly, for at least all the above reasons, claims 6 and 16-18 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 7, 8, 19 and 25 over O'Neal in view of Bartholomew and Garson

In the Office Action, claims 7, 8, 19 and 25 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over O'Neal in view of Bartholomew, and further in view of Garson et al., U.S. Patent No. 5,689,550 ("Garson"). The Applicants respectfully traverse the rejection.

Claims 7, 8, 19 and 25 are dependent on claims 1, 12 and 22 respectively, and are allowable for at least the same reasons as claims 1, 12 and 22.

Claims 7 and 8 recite, *inter alia,* a voice message that is initially stored in a voice message memory, and upon deletion of the voice message from the voice message memory, the voice message is compressed, moved and restored in a deleted voice message memory. Claims 19 and 25 recite, *inter alia*, removing a deleted voice message, upon deletion from a first memory area, compressing the deleted voice message, and storing the deleted voice message memory in a second memory area.

As discussed above, O'Neal in view of Bartholomew fails to disclose or suggest that upon deletion of a voice message, the voice message is compressed, moved and restored in a deleted voice message memory and a second memory area, as recited by claims 7, 8, 19 and 25.

The Office Action relies on Garson to allegedly make up for the deficiencies in O'Neal and Bartholomew to arrive at the claimed invention. The Applicants respectfully disagree.

Garson appears to disclose a call-detail-report in a delete queue that is deleted after it reaches its limit by percentage of memory or by number of records (col. 16, lines 23-32).

Garson discloses a delete queue containing a call-detail-report. Garson fails to disclose a novel method and apparatus for handling a deleted voice message, much less compression of a deleted voice message, as recited by claims 7, 8, 19 and 25.

Neither O'Neal, Bartholomew nor Garson, either alone or in combination, disclose, teach or suggest compression that is performed upon deletion of a voice message from a memory, as recited by claims 7, 8, 19 and 25.

Accordingly, for at least all the above reasons, claims 7, 8, 19 and 25 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 9, 20 and 26 over O'Neal in view of Bartholomew and Sweet

In the Office Action, claims 9, 20 and 26 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over O'Neal in view of Bartholomew, and further in view of Sweet et al., U.S. Patent No. 5,163,085 ("Sweet"). The Applicants respectfully traverse the rejection.

Claims 9, 20 and 26 are dependent on claims 1, 12 and 22 respectively, and are allowable for at least the same reasons as claims 1, 12 and 22.

Claim 9 recites, *inter alia,* a voice message that is initially stored in a voice message memory, and upon deletion of the voice message from the voice message memory, the voice message is compressed, moved and restored in a deleted voice message memory. Claims 20 and 26 recite, *inter alia*, removing a deleted voice message, upon deletion from a first memory area, compressing the deleted voice message, and storing the deleted voice message memory in a second memory area.

As discussed above, O'Neal in view of Bartholomew fails to disclose or suggest that upon deletion of a voice message, the voice message is

compressed, moved and restored in a deleted voice message memory and a second memory area, as recited by claims 9, 20 and 26.

The Office Action relies on Sweet to allegedly make up for the deficiencies in O'Neal and Bartholomew to arrive at the claimed invention. The Applicants respectfully disagree.

Sweet appears to disclose a digitally implemented central dictation system that allows users designated as dictators to input voice files for later retrieval and transcription (Abstract). Old voice files are deleted on a first in first out basis (Sweet, col. 12, lines 53-60). Incoming digitized voice signals are compressed by line interface controllers (Sweet, col. 12, lines 53-60).

Sweet discloses using compression of current digitized voice signals as they are being received on incoming line interface controllers. Sweet fails to disclose a novel method and apparatus for handling a deleted voice message, much less compression of a deleted voice message, as recited by claims 9, 20 and 26.

Neither O'Neal, Bartholomew nor Sweet, either alone or in combination, disclose, teach or suggest compression that is performed upon deletion of a voice message from a memory, as recited by claims 9, 20 and 26.

Accordingly, for at least all the above reasons, claims 9, 20 and 26 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claim 11 over O'Neal in view of Bartholomew and Newton

In the Office Action, claims 10, 11, 21 and 27 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over O'Neal in view of Bartholomew, and further in view of Newton, U.S. Patent No. 5,978,757 ("Newton"). The Applicants respectfully traverse the rejection.

Claim 11 is dependent on claim 1, and is allowable for at least the same reasons as claim 1.

Claim 11 recites, *inter alia,* a voice message that is initially stored in a voice message memory, and upon deletion of the voice message from the

voice message memory, the voice message is compressed, moved and restored in a deleted voice message memory.

As discussed above, O'Neal in view of Bartholomew fails to disclose or suggest a voice message that is initially stored in a voice message memory, and upon deletion of the voice message from the voice message memory, the voice message is compressed, moved and restored in a deleted voice message memory, as recited by claim 11.

The Office Action relies on Newton to allegedly make up for the deficiencies in O'Neal and Bartholomew to arrive at the claimed invention. The Applicants respectfully disagree.

Newton appears to disclose a voice messaging system that compresses voice messages as voice memory fills (Abstract). While memory utilization is low, messages can be maintained in memory using a high voice quality, low compression ratio (Newton, Abstract). As memory utilization is shrunk due to the storage of more messages, previously stored or other selected voice messages are re-compressed at a higher compression ratio (Newton, Abstract).

Newton discloses varying a compression ratio for stored current voice messages in a voice messaging system. Newton fails to disclose, teach or suggest a novel method and apparatus for the handling of deleted voice messages, much less a voice message that, **upon deletion**, is compressed and moved to a deleted voice message memory, as recited by claim 11.

Neither O'Neal, Bartholomew nor Newton, either alone or in combination, disclose, teach or suggest a voice message that is initially stored in a voice message memory, and **upon deletion** of the voice message from the voice message memory, the voice message is compressed, moved and restored in a deleted voice message memory, as recited by claim 11.

Accordingly, for at least all the above reasons, claim 11 is patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 28-30 over Checchio in view of Newton

In the Office Action, claims 1-5, 12-15 and 22-24 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Checchio et al., U.S. Patent No. 5,912,951 ("Checchio") in view of Newton. The Applicants respectfully traverse the rejection.

Claims 28-30 recite, *inter alia,* a system and method for dynamically adjusting a total storage space allocated to each of a voice first memory area and a deleted second memory area from a common total memory space to optimize a space available for the voice first memory area and the deleted second memory area.

The Office Action correctly acknowledged that Checchio discloses deleting messages from a new message container and saving the deleted messages in a saved message container (Office Action, page 10). However, the Office Action alleges that a saved message container is "analogous" to the claimed deleted voice message memory (Office Action, page 11).

Saving a file and deleting a file are distinct operations within the art. Saving a voice message in a voice messaging system has such advantages as, e.g., providing a list of voice messages that allows a user to later review the voice messages. Deleting a voice message has such advantages as, e.g., removing references to a voice message that a user must later deal with. The two operations, i.e., saving a voice message and deleting a voice message, are distinct operations within the art that are **not** interchangeably used. With electronic storage devices, although a file is deleted, usually only reference to that filed is deleted. A deleted file only become truly deleted once a new file overwrites the memory locations that the deleted file occupied. As long as the deleted file is not overwritten, the deleted file can still be retrieved. A saved file is **not** overwritten since a user desires such a file not to be overwritten. Therefore, as the Office Action acknowledges, Checchio fails to disclose a deleting a file.

The Office Action correctly acknowledged that Checchio fails to disclose or suggest dynamically adjusting a total memory area to optimize a

space for a new message container and a saved message container (Office Action, page 11). The Applicants respectfully disagree.

The Office Action relies on Newton to allegedly make up for the deficiencies in Checchio to arrive at the claimed invention. The Applicants respectfully disagree.

As discussed above, Newton appears to disclose a voice messaging system that compresses voice messages as voice memory fills (Abstract). While memory utilization is low, messages can be maintained in memory using a high voice quality, low compression ratio (Newton, Abstract). As memory utilization is shrunk due to the storage of more messages, previously stored or other selected voice messages are re-compressed at a higher compression ratio (Newton, Abstract). Deletion of voice messages from memory results in more capacity provided for new message storage (Newton, col. 6, lines 1-15).

Newton discloses varying a compression ratio for stored voice messages in an active message storage space. Newton fails to disclose, teach or suggest a novel method and apparatus for the handling of deleted voice messages, much less dynamically adjusting memory for deleted messages, as recited by claim 11.

Moreover, even if the theoretical combination of Checchio and Newton were obvious, which it is not, the theoretical combination would result in deleting messages from a new message container and saving the deleted messages in a saved message container, as disclosed by Checchio, and compression of messages in the saved message container, as disclosed by Newton. The theoretical combination would still fail to disclose or suggest the claimed invention.

Neither Checchio nor Newton, either alone or in combination, disclose, teach or suggest a system and method for dynamically adjusting a total storage space allocated to each of a voice first memory area and a deleted second memory area from a common total memory space to optimize a space

available for the voice first memory area and the deleted second memory area, as recited by claims 28-30.

Accordingly, for at least all the above reasons, claims 28-30 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,
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